Paper No. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUNTER BAUR, WALTRAUD FEHRENBACH,
BARBARA W. NE STAUDACHER,
FRIEDRICH WINDSCHEID, and RUDOLF KIEFER

Appeal No. 2004-0726
Application No. 08/627,386

ON BRIEF

Before NASE, DIXON, and BLANKENSHIP, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 20-35, 37-85 and 88-124, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellants' invention relates to a liquid crystal display device having a parallel electric field and which has a pretilt angle $\alpha_o < 30°$. An understanding of the invention can be derived from a reading of exemplary claim 20, which is reproduced below.

> 20. An electro-optical display device comprising a plurality of liquid crystal switching elements which comprise a liquid crystal layer comprising liquid crystal molecules and having a surface for display of an image which is switched under control of an electric field having a component predominantly parallel to said surface, wherein said liquid crystal molecules have a pretilt angle α_o, $0° \leq \alpha_o < 30°$, and an orientation angle β_o, $0° < \beta_o < 90°$.

No prior art references of record have been relied upon by the examiner in rejecting the appealed claims.

Claims 20-35, 37-85, and 88-124 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all of the claims of U.S. Patent 5,841,498 and U.S. Patent 5,841,499.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 31, mailed Jun. 3, 2002) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 30, filed Feb. 28, 2002) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We note that appellants have elected to group all the claims as standing or falling together at page 2 of the brief and have presented the sole argument that the prior Terminal Disclaimer, filed on Jun. 4, 1999, Paper Number 16, explicitly refers to the two patents now applied against the claims under the doctrine of obviousness-type double patenting. (See brief at pages 2-3.) Appellants argue that the two patents relied upon in the rejection already have Terminal Disclaimers filed in their prosecution history as noted on the front of each patent.

Appellants do not dispute that the examiner is in error in the rejecting the claims under the judicially created doctrine of obviousness-type double patenting, but asserts that the prior Terminal Disclaimer is adequate to obviate the admitted proper rejection. Here, appellant argues that the term of the patent would be set at the date of the expiration of the '867 patent. (See brief at pages 2-3.) We agree with appellant that the prior terminal disclaimer meets all of the requirements as set forth in 37 CFR 1.321.

Therefore, we find that the prior Terminal Disclaimer obviates the obviousness-type double patenting rejection, and we cannot sustain the rejection.

The examiner maintains at page 3 of the answer that the judicially created doctrine of obviousness-type double patenting is based on public policy and is to prevent harassment by multiple assignees. Here, we find that the Terminal Disclaimer filed by appellants includes a statement that any patent granted on the application will be enforceable only for such period that it and the three patents are co-owned. Therefore, we do not find that the prior Terminal Disclaimer is deficient for this reason. The examiner maintains that if the maintenance fees are not paid on the '867 patent, it may impact on the assignment of the other patents. (See answer at page 3.) We disagree with the examiner and find that it is the full statutory term of the patent rather than the payment or nonpayment of any maintenance fees which is of consideration. Therefore, this argument by the examiner is not persuasive.

CONCLUSION

To summarize, the decision of the examiner to reject claims 20-35, 37-85, and 88-124 under the judicially created doctrine of obviousness-type double patenting is reversed.

REVERSED

JEFFREY V. NASE
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

JLD/vsh

MILLEN WHITE ZELANO & BRANIGAN
ARLINGTON COURTHOUSE PLAZA I
2200 CLARENDON BLVD SUITE 1400
ARLINGTON, VA 22201